

REMARKS

The Examiner rejected claims 1 – 29 under 35 U.S.C. 101.

Independent claim 1

Regarding claim 1, while Applicant contends that the pending claim 1 recites statutory subject matter, in order to advance prosecution, Applicant has amended claim 1 to clarify how the recited subject matter produces a useful, concrete and tangible result.

Independent claim 12

Applicant submits that claim 12, directed to an article comprising a machine-readable medium that stores machine-executable instructions, recites statutory subject matter. The Examiner states that “there is no tangible (real world) result found due to ... the mere ‘determining’ functionality of the machine operations as would be controlled by ... the instructions in claim 12.” However, Applicant submits that the claimed functionality provided by the machine-executable instructions that are stored on a machine-readable medium represents an article recited in *Beauregard* format, which is a format that has been deemed sufficiently tangible to be considered statutory. *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

Even if the Examiner were to characterize claim 12 as directed to descriptive material as outlined in the MPEP guidelines on “Computer-Related Nonstatutory Subject Matter” (in section 2106.01), these guidelines suggest that such subject matter when tangibly embodied on a computer readable medium is statutory in most cases. For example, the Examiner has described claim 12 as reciting “functionality,” and the guidelines suggest that “when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”

Independent claim 22

Claim 22 is directed to an apparatus. The Examiner states that "there is no tangible (real world) result found due to ... the mere 'determining' functionality of the machine operations as would be controlled by ... the functions/processing steps in claim 22." However, Applicant submits that the claimed apparatus represents statutory subject matter. Not only is there no question as to whether the claim is directed merely to an abstract idea, but the claimed apparatus is in a class of invention specifically prescribed by 35 U.S.C. 101. For example, even in *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), in which the court held that claims 1-4 and 6 were directed to non-statutory subject matter, claim 5 was clearly directed to statutory subject matter, even though it depended on claims 1-4, because it was directed to a machine. *Warmerdam*, 33 F.3d at 1360.

Dependent Claims

Applicant submits that the dependent claims are similarly directed to statutory subject matter for at least the reasons discussed above for their respective independent claims.

All claims should now be in condition for allowance.

Applicant additionally notes that the finality of the present Office Action is premature, according to the MPEP section 706.07(a), which states "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" Since the present 35 U.S.C. 101 ground of rejection is new and not necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement, Applicant requests withdrawal of the finality of the present Office Action.

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No fee is believed to be due. Please apply any charges or credits to deposit account 06-1050, referencing Attorney's Docket No. 10559-707002.

Respectfully submitted,

Date: _____

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